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09/207,954	12/09/1998	YU SUNG (EDUARDO) YEH	733-003	7476
22850	7590	03/11/2004	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			ALVAREZ, RAQUEL	
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 33

Application Number: 09/207,954
Filing Date: December 09, 1998
Appellant(s): YEH ET AL.

Yu Sung Yeh
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 10/7/2003.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims stand or fall into two groups:

Group I. Claims 35 and 45 and

Group II. Claims 36, 37 and 46 and provides reasons as set forth in 37 CFR

1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5,857,189 RIDDLE 01-1999

Mendler, C. "Competition drives operators toward retail innovation"

CommunicationsWeek International, no. 160, no. 160 (March 4, 1996), pp. 32+

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 35-37 and 45-46 rejected under 35 U.S.C. 103(a) as being unpatentable over publication, titled, Mendler "Competition drives operators toward retail innovation" hereinafter Mendler. This rejection is set forth in prior Office Action, Paper No. 28 and repeated below.

With respect to claim 35 , Mendler teaches receiving a telephone call from a Caller at said server (i.e. the customer calls MCI and provide the numbers of their closest friends)(page 3, paragraphs 4 and 5); querying said caller by said server for a third-party telephone number(page 3, paragraphs 4 and 5); receiving said third-party telephone number (i.e. the system receives the third-party telephone numbers to enable the customer to receive discounts calls on those specified numbers)(page 3, paragraphs 4-5).With respect to establishing by said server a telephone call between said caller and the third party and delivering to said caller and said third party a marketing message during said telephone conference call. Since, the MCI system is partly responsible for taking 5 percent of AT&T's market share(page 3, paragraph 4) and since it is well known to place conference calls that deliver marketing messages. For example, mortgage companies would call the individuals responsible for decision

making by conference calls to deliver marketing message that would motivate both parties to agree on certain specifics of a proposed deal or contract. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included delivering a conference marketing message to the friends and family of the customer because such a modification would save time by enabling the MCI operators to deliver the same message to the two parties at the same time.

Claim 36 differs from claim 35 in that it further recites receiving a call from a caller having a calling card, said calling card having a predetermined number of minute credits associated with it. Official notice is taken that is old and well known for callers to place phone calls with calling cards said calling cards have a predetermined number of minutes based on the money amount purchased. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included using a calling card because such a modification would enable the caller to prepay for the call ahead of time.

Claim 37 further recites adding an additional number of minutes credits to said calling card when said marketing message is delivered. Official notice is taken that is old and well known to credit or pay customers for their attention to advertisements. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included adding a credit to said calling cards when said marketing message is delivered because such a modification would motivate the customers to listen to the message.

Claims 45 and 46 further teaches delivering the marketing message based on

demographic information of the caller. Official notice is taken that it is old and well known in marketing to target advertisements based on demographic information of a person. For example, a couple with children might receive a baby food commercial to induce the customer to buy a needed product. It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have included delivering the marketing message based on demographic information of the caller because such a modification would produce the above mentioned advantage.

(11) Response to Argument

Appellant argues that the patent reference Riddle does not teach delivering a marketing message. The Examiner disagrees with Appellant because Riddle clearly teaches a system and method which enables teleconference members to share files during a conference call (abstract). A file sharing accessory allows advertisements (205) to be viewed by the 2 parties. Riddle teaches promoting to the 2 parties that a file is available (see in Riddle col. 1, lines 47-59 and col. 3, lines 45-53). An advertisement equates to a marketing message. Marketing as defined by Merriam Webster's Collegiate Dictionary means "the process or technique of promoting, and distributing a product or service" and this is taught by Riddle.

With respect to a server performing the recited tasks of the claims. The Examiner asserts that Mendler (MCI reference) teaches on page 3, paragraph 4 putting the functions of the system in a "client-server graphical environment" which therefore teaches that the steps are automated, performed by a machine rather than by a person.

The Examiner asserts that the combination of the references teach the following claim elements:

Mendler, MCI reference teaches receiving a telephone call from a caller at said server and querying said caller by said server for a third-party telephone number and receiving said third-party telephone number at said server (i.e. the caller calls an automated service and the caller is asked to provide the number of their closest friends)(Mendler, MCI reference page 3, paragraphs 4-5).

With respect to establishing a telephone conference between the caller and the third party and delivering a marketing message during said telephone conference call. Riddle teaches a system and method which enables teleconference members to share files during a conference call (Abstract). Promoting to the 2 parties that a file is available (see in Riddle col. 1, lines 47-59 and col. 3, lines 45-53).

It would have been obvious to a person of ordinary skill in the art at the time of Applicant's invention to have modified Mendler, MCI with the teachings of Riddle of delivering a marketing message during a teleconference call to 2 parties because such a modification would save time and cost by delivering the message to the 2 parties.

With regard to the examiner's use of Official Notice, applicant asserts that "there is nothing in the prior art of record" to substantiate the examiner's assertion, but this is not relevant to the use of Official Notice. While applicant may challenge the examiner's use of Official Notice, applicant needs to provide a proper challenge that would at least cast reasonable doubt on the fact taken notice of. See MPEP 2144.03 where In re Boon

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is mentioned. Applicant may do this by asserting that the fact the examiner took notice is incorrect or that the applicant is not aware of the fact taken notice of.

In response to applicant's argument that the claims do not require prepaying for anything, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


Raquel Alvarez
Examiner
Art Unit 3622

R.A.
12/18/03

Conferees
Eric Stamber 

James Trammell 

JOSEPH SOFER
SOFER & HAROUN
342 MADISON AVENUE
SUITE 1921
NEW YORK, NY 10173